

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. **Rejection of Claims 1-27 under 35 U.S.C. §112, second paragraph.**

Claims 1-27 were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

The rejection contends that the phrasing "*sufficient account information to impart transaction functionality*" in Claims 1, 11, 18 and 19 and similar forms render these claims, and the claims which depend therefrom, vague and indefinite.

However, in view of the teachings in the specification and what is known to one of ordinary skill in the art this phrasing does not appear to be confusing.

One of ordinary skill in the art of purchase transaction devices, such as credit cards, smart cards and the like would readily recognize what forms of "*account information*" are necessary to "*impart transaction functionality*". For example a debit card form of mechanism requires a user name, account reference and a security code such as a PIN. Each form of transaction device can require different forms of information to identify the user/account, and provide for secure access. The plurality of protocols is described in the specification, such as seen on page 8, lines 7-23:

"...Communication protocols include those that allow a digital wallet to specify which of several possible data structures to use for a transaction and communication protocols that allow the digital wallet and other devices to securely share data with the data-transaction device. The data-transaction device may represent a single account such as a particular credit card, or it might represent multiple accounts such as a credit card, telephone card and debit card.

Data-transaction device 12 can be configured to function compatibly with existing point of sale terminals at retail locations and provide encoded account information compatible with existing systems such as magnetic stripe and bar codes. A magnetic stripe generator on the data-transaction device can be programmed to represent any account.

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

Additionally, the screen on the data-transaction device can be used to display bar codes that can be scanned by existing POS terminals. Alternatively, the card may also have a smart card chip that functions similarly to standard credit cards. Thus there is a capability to access multiple accounts from a single card, thereby eliminating the need to carry many different credit cards, such as debit and loyalty cards, but still providing the opportunity to use different accounts based on the user's choice."

The specification also describes how the system can operate on any of these protocols, see page 4, lines 23-28:

"The user will preferably have access to financial and account status information regardless of the type device used to access the system. For example, devices such as smart cellular phones, home personal computers, web-enabled kiosks and personal digital assistants (PDAs) and other financially enabled e-Commerce devices can receive information automatically when linked to the system."

The Applicant respectfully submits that the language of these claims is clear in this regard, and in particular in view of the material provided in the specification and what is known to ordinary practitioners. To provide a detailed data structure for this aspect of the invention in the claims would limit the applicability of the system much more narrowly than accorded by the specification. The format of the account information is not at issue. However, Applicant's representative would be open to hearing suggestions that would clarify these aspects without inducing undue limitations.

Nevertheless, the Applicant has amended Claims 1, 11, 18 and 19 to further recite that the account information is "about the user account, or accounts, associated with said device identifier to impart transaction functionality to said data terminal on behalf of a user". (emphasis added) It should be readily recognized that accessing an account requires an identifier for the account as well as security control, since these elements can be implemented in a variety of ways on different forms of transactions devices. The claims state this aspect in broad terms.

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

2. Rejection of Claims 1-27 under 35 U.S.C. § 103(a).

Claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Northington et al. (U.S. No. 6,128,602).

Claims 1, 11, 16, 18 and 19 are the independent claims within this grouping of claims. Applicant has carefully considered the grounds for rejection and responds as follows.

Claim 1. Independent Claim 1 describes a system that includes both a financially-enabled e-commerce device and a transaction and information clearing house (TIPCH).

The rejection of Claim 1 considers a data terminal attached to the accounting system of Northington as equivalent to the financially enabled e-commerce device as recited in Claim 1. Applicant disagrees because the terminal of Northington only allows access to the computer system itself, which executes the financial transactions. Even the sections of Northington referred to by the Examiner in support of the rejection make this point. Referring to column 5, lines 15-25, it is stated in Northington.

"System 100 communicates with one or more independent computer systems, represented in FIG. 1 as financial systems 106 and 112, via a communications network 105. Financial systems 106 and 112 may represent such computer systems as credit card networks, automatic teller networks, electronic banking networks and systems, governmental financial networks, and other types of electronic commerce networks and systems through which an entity performs purchasing, spending, invoicing, payment or credit receipts, and other financial transactions."

It can be seen that it is system 100 and not terminal 110 that is configured for performing electronic commerce. The terminal only provides access to this functionality by users.

The rejection also considers that Northington teaches populating the data terminal with "sufficient information" to impart "functionality" to the remote data terminal on behalf of the user. This is not what is stated in Applicant's claim. Claim 1 recites

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

"sufficient account information" and specifically describes functionality as *"transaction functionality"*, which would be understood as providing the terminal with the capability to execute financial transactions, such as purchases. This transaction functionality is not available within the terminal of Northington. And, it should be appreciated that providing such functionality to the terminal would be contrary to the intent of the Northington invention, which is to consolidate processing into system 100 for the accounts of the entity.

Northington thus does not teach all claim limitations, and the rejection is based only on the similarity of the inventive concept. The suggestions to modify to provide populating with account information lack specificity, are based on hindsight in view of Applicant's teachings, and still remain unworkable as they are based on improper assessments of the relevant teachings. Northington's purpose is to consolidate transactions into one system (system 100) across the corporate entity, wherein distributing transaction functionality to separate e-Commerce devices would be contrary to that intent. Modifications to provide that functionality, as it is untaught within the reference, go against the recited purpose of the Northington reference and would be both unnecessary and contrary to the purpose of the reference.

The distinction of these mechanisms relating to the data terminal, and the automatic population thereof, are not incidental or a simple design choice, but illustrate fundamental differences between the system of Northington and that of the Applicant. Northington provides a system on which the activities of independent financial systems within a single business entity are consolidated, or brought together, within system 100 (see Background col. 1, lines 21-26 and col. 2, lines 23-26), *"without the need for expensive and time consuming backroom procedures"* as found in col. 2, lines 29-32 of Northington.

Applicant's invention is directed to different purposes and operates according to different principles of operation than found in Northington. Specifically, the system of

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

the Applicant allows a "*financially-enabled e-commerce device*" of a user to be populated with information about the user accounts so that it may execute transactions. Embodiments describe the e-commerce devices as a digital wallet and so forth.

Furthermore, Applicant has amended Claim1, and similarly the other independent claims, to recite these aspects with greater clarity.

The use of a "*a device identifier retained within said financially-enabled e-commerce device*" is described as well as how it relates to the operation of the TIPCH and the data terminal. The TIPCH is configured for maintaining information for numerous user entities, "*a plurality of user accounts*", and these entities are associated with the user account information by the device identifier. The transfer of information from the TIPCH is further described as being "*in response to receipt of said device identifier*".

These additional distinctions can be seen to clearly overcome the teachings of Northington which does not describe associating a selection of one of a plurality of accounts using device identifiers. The use of user sign on procedure on non-dedicated terminals within Northington to limit access to information for the single entity is clearly not equivalent.

Consequently the Northington reference does not provide support for the rejection and fails in a number of areas, including but not limited to the following: all claim limitations are not taught, rejection based only on similarity of inventive concept or idea, modification based on hindsight in view of applicant's teaching, new principle of operation utilized, solved a different problem, lack of specificity of suggestion to modify, elements in references are not equivalent, no need of element within references, unsuggested combination, no motivation to combine, obvious to try is not a standard of obviousness, invention to be considered as a whole, and so on, any of which being sufficient to overcome the rejection.

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

Therefore, the Applicant respectfully submits that Claim 1, as well as the claims which depend therefrom, describe elements which are not taught or suggested by the relied upon reference, and for which no suggestion, motivation or incentive is found in the reference for adaptation (although a great deal of dis-incentive is found). Accordingly the Applicant respectfully requests that the rejection of Claim 1 and the claims which depend therefrom should be withdrawn.

Claim 11. Independent Claim 11 describes an electronic commerce system having data terminal and TIPCH for populating the data terminal with information. Original Claim 11 recited

The rejection of Claim 11, is formed similarly to that of Claim 1, in that it considers a data terminal attached to the accounting system of Northington as equivalent to the financially enabled e-commerce device as recited in Claim 11. As discussed with regard to Claim 1, however, the terminal of Northington does not comport to this aspect of Claim 11 because the terminal of Northington only allows access to the computer system itself, which executes the financial transactions. Again, the sections of Northington referred to by the Examiner in support of the rejection, column 5, lines 15-25, make the point that the transactions functionality is consolidated into system 100, and are not being distributed into separate devices, such as terminal 110, which only provides access to this functionality by users.

The rejection directs the reader to the rejection of Claim 1, in regards to the claim recitations of "*sufficient account information to impart transaction functionality*" to the remote data terminal on behalf of the user. In the rejection of Claim 1, however, it has been shown that not all claim aspects were considered. That a user can access information from a remote terminal in the Northington system is not equivalent to an e-commerce device being downloaded with "*sufficient account information to impart transaction functionality*". This transaction functionality is not available within the terminal of Northington and is contrary to the consolidation purpose for which

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

Northington is directed.

Claim 11, as with Claim 1, does not provide proper support for the rejection of the claim as it does not teach all claim limitations. Applicant's invention is also directed to different purposes and operates according to different principles of operation than found in Northington. Specifically, the system of the Applicant allows a *"financially-enabled e-commerce device"* of a user to be populated with information about the user accounts so that it may execute transactions. Embodiments describe the e-commerce devices as a digital wallet and so forth.

Additionally, Applicant has amended Claim 11 to recite these aspects with greater clarity. The use of a *"a device identifier retained within said financially-enabled e-commerce device"* is described as well as how it relates to the operation of the TIPCH and the data terminal. The TIPCH is configured to *"to gather electronic information from a financial institution or vendor, for a user having an account within a plurality of separate user accounts within said TIPCH"*.

The transferring of information to the e-commerce device is now described as being *"in response to receipt of said device identifier"*.

These additional distinctions can be seen to even more clearly overcome the teachings of Northington which does not describe associating a selection of one of a plurality of accounts using device identifiers. The use of user sign procedures on non-dedicated terminals within Northington to limit access to information for the single entity is clearly not equivalent.

Consequently, the Northington reference does not provide support for the rejection of independent Claim 11 and is similarly lacking in that all claim limitations are not taught, rejection is based only on similarity of inventive concept or idea, modification is based on hindsight in view of applicant's teaching, new principle of operation utilized, solved a different problem, lack of specificity of suggestion to modify, elements in references are not equivalent, no need of element within references, unsuggested

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

combination, no motivation to combine, obvious to try is not a standard of obviousness, invention to be considered as a whole, and so on, any of which being sufficient to overcome the rejection.

Therefore, the Applicant respectfully submits that Claim 11, as well as the claims which depend therefrom, describe elements which are not taught or suggested by the relied upon reference, and for which no motivation is found in the reference for adaptation. Accordingly the rejection of Claim 11 and the claims which depend therefrom should be withdrawn.

Claim 16. Independent Claim 16 describes a *"method for permitting users to conduct an electronic commerce transaction"*.

The rejection of Claim 16 is similar to those of Claims 1 and 11 and it suffers from similar shortcomings. The aspects recited in Claim 16, which were not recited in prior independent Claim 1 and Claim 11, were improperly equated with aspects of the Northington reference.

Specifically, the *"unique identifier"* of the *"data-transaction financially-enabled e-commerce device"* has been equated to the user sign on for terminal 110 of Northington. A device identifier, as the name implies, identifies the device to the system. This is used as the device may or may not be coupled to the TIPCH, unlike terminal 110 of Northington. The identifier described by the Applicant in Claim 16 provides an association between the e-commerce device and the account(s) of a given user. In Northington, however, there is no need of a device identifier as the entire system provides information solely about the corporate entity. The security procedures of Northington only limit the extent to which a user can obtain information from, or give commands to, direct the operation of system 100 for the accounts of that one entity.

As a result, the rejection of Claim 16 is not properly supported by the teachings of Northington, which does not teach all claim limitations. Applicant's invention is also directed to different purposes and operates according to different principles of operation

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

than found in Northington.

In addition, Applicant has amended Claim 16 to provide greater clarity. In particular, *"sufficient account information about the user account, or accounts, associated with said device identifier to impart transaction functionality"* describes the association of device identifier with the user accounts. The step of *"configuring a transaction and information clearing house (TIPCH) to receive electronic content from [[a]] at least one vendor or financial institution"* is further clarified as *"for each individual user within a plurality of users"*. The populating of the device is now described as being *"in response to receipt of said device identifier"*. These aspects of the invention as described with regard to Claims 1 and 11 provide clear distinction over the teachings of the Northington reference.

Consequently, the Northington reference does not provide support for the rejection of independent Claim 16 with the rejection subject to intractable failings in a number of areas as mentioned previously.

Therefore, the Applicant respectfully submits that Claim 16, as well as the claims which depend therefrom, describe elements which are not taught or suggested by the relied upon reference, and for which non motivation is found in the reference for adaptation. Accordingly the rejection of Claim 16 and the claims which depend therefrom should be withdrawn.

Claim 18. Independent Claim 18 describes *"a transaction and information processing clearing house (TIPCH) for use within an electronic transaction system"*. The preamble itself breathes life into the claim and provides distinction over the cited Northington reference, which describes consolidating information for the single business entity. Independent Claim 18 recites with particular clarity a number of aspects which do not comport whatsoever to the teachings of Northington, in addition to similar intractable shortcomings as were already brought out with regard to Claims 1, 11 and 16.

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

Described within Claim 18 is the association between the accounts and the device identifiers: *"secure database identifying accounts corresponding to particular transaction device identifiers"*. However, there is no support provided in the rejection for this recited aspect of the invention. Applicant notes that Northington does not provide anything which comports to identifying accounts within the TIPCH based on the device identifiers. It should be noted that Northington maintains accounts for but ONE entity, the corporation.

In putting forth the claim 18 rejection, it appears that the phrase *"within a plurality of financially-enabled e-commerce devices"* was ignored. This aspect of Claim 18 denotes the differences in both purpose and principles with the Northington reference.

Applicant respectfully asserts that the rejection of Claim 18 is not properly supported by the teachings of Northington, which does not teach all claim limitations, and suffers from additional intractable problems.

Applicant has amended Claim 16 to provide greater clarity. In particular, *"sufficient account information about the user account, or accounts, associated with said device identifier to impart transaction functionality"* describes in yet another portion of the claim the association of device identifier with the user accounts. The populating of the device is now described as being *"in response to said particular transaction device identifiers"*. These aspects of the invention as described with regard to Claims 1, 11 and 16 provide clear distinction over the teachings of the Northington reference.

Consequently the Northington reference does not provide support for the rejection of independent Claim 18 with the rejection falling short in a number of areas.

Therefore, the Applicant respectfully submits that Claim 18, as well as the claims which depend therefrom, is patentable over the Northington reference. Accordingly the rejection of Claim 18 and the claims which depend therefrom should be withdrawn.

Claim 19. Independent Claim 19 *"a system for executing and tracking financial transactions"*. Independent Claim 19 recites a number of aspects with particular clarity

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

that do not equate to teachings within Northington, in addition to the shortcomings previously brought out with regard to Claims 1, 11 and 16.

The rejection improperly equates aspects of the information repository (IR) with that of Northington. In particular, gathering the account information for each registered user, is partially equated to providing passwords to users, wherein the rejection considers this addition would be obvious for security. However, the aspect would require the purpose and principle of operation of Northington to be changed, which would only occur as a result of improper hindsight based on Applicant's teachings.

The limitation of a portable transaction device is considered obvious, however, this aspect also is contrary to the consolidation teachings of the Northington reference, wherein the intent was to eliminate transactions being executed by external systems, from which necessary "*backroom operations*" arose. The failings described with regard to Claims 1, 11 and 16 are also generally applicable to Claim 19.

Applicant has amended Claim 19 to provide greater clarity, and distinction. In particular, the information "*is gathered for each of a plurality of registered users of said TIPCH*". Description of the portable transaction device is amended to recite with the account information with greater clarity and to recite how the portable transaction device can be used to execute transactions "*with or without a connection established to said TIPCH*". It will be appreciated that use of a separate portable terminal, disconnected from system 100 of Northington, is not taught by Northington and is contrary to the intent of Northington.

Accordingly, the recited elements of Applicant's Claim 19 cannot be properly equated to the Northington reference, nor is there a basis of support for an obviousness rejection based on the reference.

Therefore, the Applicant respectfully submits that Claim 19, as well as the claims which depend therefrom, are patentable over the Northington reference and respectfully requests that these rejections be withdrawn.

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

3. Amendment of Specification.

The specification was amended to correct typographical errors found when preparing this response. These amendments to the specification do not constitute additional disclosure and serve only to correct and clarify the existing disclosure. Applicant apologizes for any inconvenience which this may have caused the Examiner.

4. Amendment of Claims 1, 8, 10, 11, 15, 16, 18-21 and 24-27.

Claims 1, 11, 16, 18 and 19. The independent claims of the application were each amended in an attempt to provide additional clarity with regard to "account information that impart transaction functionality", the added text being in these claims "about the user account, or accounts, associated with said device identifier", which ties the use of device identifier into the accounts retained in the TIPCH. Support for this aspect is found in the specification, including the following.

At page 7, line 32 the nature of the account information is described according to one embodiment: *"Data-transaction device 12 can be configured to function compatibly with existing point of sale terminals at retail locations and provide encoded account information compatible with existing systems such as magnetic stripe and bar codes".*

At page 11, lines 5-8 the maintenance of this information within the TIPCH is described according to embodiments of the invention: *"TIPCH 18 regularly obtains updated account information and maintains the information in an electronic database for each registrant. Updated information is transmitted to the user when the user accesses TICPH 18. In another embodiment, the TIPCH seeks and obtains updated information when the user and automatically downloads the information to data transaction device 12 when the system is accessed by the user."*

The use of the device identifier, such as in "a device identifier retained within said financially-enabled e-commerce device" is found in prior independent claims 16, 18

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

and 19, as well as throughout the specification.

The phrase "maintaining information for a plurality of user accounts" as recited in Claim 1 finds support in the original claims, including independent Claim 18, as well as throughout the specification.

Support for "and in response to receipt of said device identifier" associated with the transfer of electronic information to the data terminal when said data terminal is connected to said TIPCH is found in original claims 16, 18 and 19 as well as throughout the specification.

Claim 8. Dependent Claim 8 was amended to correct a typographical error, wherein "users" was replaced with "user's".

Claim 10. Dependent Claim 10 was amended to correct antecedent basis, with "the" replaced by "a".

Claim 15. Dependent Claim 15 was amended to correct formatting of the preamble, according to our in-house guidelines. The preamble "The distribution system" referring to a portion of Claim 14 to which it depends, was replaced with "A system" and the reference to the distribution portion of Claim 14 added to the body of the claim.

Claims 20, 21, 24-27. Dependent Claims 20, 21, 24-27 were amended to eliminate unnecessary parenthetical expressions and abbreviations which did not add to the claim, including (TIPCH), (e-commerce) and (PDAs).

5. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicants have made these amendments in order expedite allowance of the currently pending subject matter. However, Applicants do not acquiesce in the original ground for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without

Appl. No.: 09/737,277
Amdt. Dated: 5/24/2005
Off. Act. Dated: 2/24/2005

forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicants reserve the right to pursue the original scope of these claims in the future, such as through continuation practice for example.

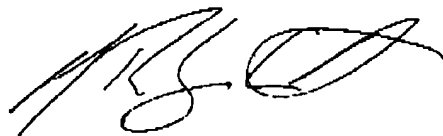
6. Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present Application to pass to issuance.

In the event any further matters remain at issue with respect to the present Application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this Application.

Date: 5/24/05

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
M. Robyn Carrillo, Reg. No. 47,474
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010